

REMARKS

Claims 2-5, and 7-25 are pending. No new matter has been added by way of the present amendments. For instance, claims 10 and 14 have been placed into independent format and now include subject matter from claims 1 and 6, respectively. Claim 10 has also been amended to include at least one image receiving layer. The dependency of several claims has been altered, for instance, claims 2-5, 7-9, 13 and 18. Also, new claim 22 is supported by originally filed claims 1, 10 and 12. New claim 23 is supported by originally filed claim 12. New claim 24 is supported by originally filed claims 1, 10 and 13. Lastly, new claim 25 is supported by originally filed claim 13. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Request for Rejoinder

Applicants respectfully request that the Examiner rejoin all claims which are currently withdrawn from consideration. For instance, claims 2-5 and 7-9 have been amended to depend either upon claim 10 or claim 14. Also, claims 19-21 are directed to methods of using allowable products and therefore should also be

rejoined.

Issues under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claim 13 under 35 U.S.C. § 112, second paragraph for the reasons recited at page 2 of the outstanding Office Action. Applicants respectfully traverse.

The Examiner asserts that the coated transfer sheet of "claim 9" recited in claim 13 lacks antecedent basis. Applicants submit that "claim 9" in claim 13 has been amended to recite "claim 10." Accordingly, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

Obviousness-type Double Patenting

The Examiner has rejected claims 10-18 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1, 33, 36, 37, 55 and 56 of U.S. Patent No. 6,358,660. Applicants respectfully traverse.

Applicants are attaching hereto a Terminal Disclaimer directed to U.S. Patent No. 6,358,660. Accordingly, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

Issues under 35 U.S.C. § 102(b)/103(a)

The Examiner has rejected claim 10 under 35 U.S.C. § 102(b) as

being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over Shuman, U.S. Patent No. 4,592,946; Magnotta, U.S. Patent No. 4,536,434; or JP 03-274186A. Applicants respectfully traverse these rejections.

Applicants respectfully submit none of the references cited by the Examiner suggest or disclose the subject matter recited in independent claims 10, 14, 22 or 24. For instance, claim 10 relates to a coated transfer sheet comprising: a substrate having a first and second surface; at least one release layer overlaying said first surface, said release layer comprising a film forming binder, and a wax emulsion; and at least one image receiving layer overlaying said at least one release layer.

Claim 14 is directed to a coated transfer sheet comprising: a substrate having a first and second surface; and at least one release layer overlaying said first surface, said release layer comprising a film forming binder, a wax emulsion, and a retention aid.

Claim 22 relates to a coated transfer sheet comprising: a substrate having a first and second surface; at least one release layer overlaying said first surface, said release layer comprising a film forming binder, and a wax emulsion; and a barrier layer in-between said first surface of the substrate and said at least one release layer.

Lastly, claim 24 is directed to a coated transfer sheet comprising: a substrate having a first and second surface; at least one release layer overlaying said first surface, said release layer comprising a film forming binder, and a wax emulsion; and an antistatic layer coated on said second surface of the substrate.

None of the coated transfer sheets recited in any of independent claims 10, 14, 22 or 24 is either suggested or disclosed in the references cited by the Examiner. For a rejection to constitute "anticipation", all material elements of a claim must be found in the cited art reference. In re Marshall, 577 F.2d 301, 198 U.S.P.Q. 344 (CCPA 1978). However, since each element is not found in the references, there exists no anticipation.

Also, the Federal Circuit has explained that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable expectation of success. Rockwell Int'l Corp. v. United States, 47 USPQ2d 1027, 1033 (Fed. Cir. 1998). Thus, the prior art must first suggest or provide motivation to one of ordinary skill in the art that the subject matter claimed should be pursued. Then, there must be a reasonable expectation of success. However, since the references cited by the Examiner fail to suggest or disclose each element of the claims, there exists no motivation to prepare the

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presently claimed subject matter, much less a reasonable expectation of success. Accordingly, there exists no obviousness.

In view of the above, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$510.00 is attached hereto.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig A. McRobbie (Reg. No. 42,874) at the telephone number of the undersigned below.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Terminal Disclaimer